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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ALI, MOHAMMAD

ART UNIT PAPER NUMBER

2166

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,788

Applicant(s)

DENDA ET AL.

Examiner

Mohammad Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 8/12/05 has been entered.

Claims 1-10 are pending in this Office Action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumi et al. ('Matsumi' hereinafter), USP 6,711,343 in view of Fujinamo et al. ('Fujinamo' hereinafter), USP 6,385,152.

With respect to claim 1,

Matsumi discloses an information recording and reproducing apparatus for recording program information reproduced from an information recording medium or program information supplied via a communication network into recording device (see col. 6, lines 2-10, Matsumi), said apparatus comprising:

a first recording unit, provided in said recording device, for recording said program information reproduced from the information recording medium or said program information supplied via the communication network (see col. 6, lines 6-10, Matsumi);

a second recording unit, provided in said recording device, for recording title information corresponding to said program information prior to recording said program information (see col. 27, lines 17-26, Fig. 12(a), Matsumi); and

control means for, when said program information is recorded into said first recording unit (a control means for controlling said recording/reproducing means in accordance with said command signals or said operation signal, see col. 7, lines 46-50, Matsumi), (a) obtaining management information for managing said program

information recorded in the information recording medium or supplied via the communication network (see col. 27, lines 17-29, Matsumi), (b) in case that the title information corresponding to said program information is obtained by searching (see col. 25, lines 6-10, Matsumi) through said second recording unit based on the management information obtained, appending (by recording file system information B having the data having already been recorded and the append-recorded data, a normal condition can be restored, see col. 27, lines 30-32 and lines 59-61, Matsumi) the title information obtained to said program information so as to be recorded into said first recording unit (see col. 27, lines 30-34, Matsumi), and (c) in case that the title information corresponding to said program information is not obtained by searching through said second recording unit based on the management information obtained, appending information indicating an absence (the file system information A is recorded in data having already been recorded. The same file system information A is recorded twice, and the information title end indicating the end position of the program is set so as to indicate the recording end position of the entry of first file system information and then recorded. The file system information A is recorded in two adjacent areas; an address indicating the position between the two areas is recorded at the predetermined position of the tape 110 or on the additional recording medium 113. After recording is carried out, if additional recording is carried out by a conventional apparatus not conforming to the file system information, the file system information A recorded at the second time is not recognized, data is recorded from the information title end indicating the end position of the program, and the file system information A recorded at the

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second time is deleted completely. In this condition, an abnormal condition can be recognized because two pieces of the file system information A are not present, and file restructuring can be carried out without problems hereafter because the file system information A itself regarding filed data having already been recorded remains. By recording the file system information B having the data having already been recorded and the append-recorded data the normal condition can be restored, see col. 27, lines 35-61, Matsumi) of the title information to said program information so as to be recorded into said first recording unit (see col. 28, lines 19-22, Matsumi).

wherein said title information comprises at least one of disc title, the name of a artist, genre, the year of sale of disc track title and the artist(s) for respective track(s) (see Fig. 32).

Matsumi does not explicitly indicate the claimed "communication network".

Fujinami discloses claimed communication network (as presentation media for presenting a computer program to be executed for carrying out the processing to the user, communication media network and a satellite can be used in addition to a magnetic disc, a CD-ROM and a recording medium such as solid-state memory, see col. 24, lines 45-50, Fujinami).

It would have been obvious to one ordinary skill in the recording media processing art at the time of the present invention to combine the teachings of the cited references because the communication network of Fujinami's teachings would have allowed Matsumi's system in the recording/playback environment to capable of recording data distinguishing overwrite recording from append recording as suggested

by Fujinamo at col. 1, lines 11-14. Communication network as taught by Fujinamo improves to judge the indication of append-recording (see col. 1, lines 50-51, Fujinamo).

As to claim 2,

Matsumi teaches wherein, when updated title information is supplied by way of an information recording medium or via the communication network, said control means records said updated title information into said second recording unit, and searches through said second recording unit (after updating) for the title information corresponding to said program information appended with the information indicating the absence of the title information, and when the title information corresponding to said program information is obtained, said control means appends the title information obtained to said program information so as to be recorded into said first recording unit (see col. 27, lines 21-29 and col. 28, lines 19-22, Matsumi).

As to claim 3,

Matsumi teaches wherein said control means searches through said second recording unit after updating, based on the management information for managing said program information appended with the information indicating the absence of the title information (see col. 34, lines 48-50, Matsumi).

As to claim 4,

Matsumi teaches further comprising one of the followings: reproducing means for reproducing the information recording medium having recorded the updated title information (see col. 27, lines 50 to col. 28, lines 2, Matsumi); and

receiving means for receiving the updated title information supplied via the communication network (see col. 20, lines 63-66, Matsumi).

With respect to claim 5,

Matsumi discloses a method of appending title information for appending title information to program information reproduced from an information recording medium or program information supplied via a communication network so as to be recorded into recording device (see col. 6, lines 2-10, Matsumi), said method comprising:

the step of recording said program information reproduced from the information recording medium or said program information supplied via the communication network into a first recording unit provided in said recording device (see col. 6, lines 6-10, Matsumi);

the step of, when said program information is recorded into said first recording unit, obtaining management information for managing said program information recorded in the information recording medium or supplied via the communication network, and, based on the management information obtained, searching through a second recording unit equipped in said recording device provided for recording title information corresponding to said program information prior to recording said program information (see col. 27, lines 17-26, Fig. 12(a), Matsumi); and

the step of appending the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is obtained in said step of searching (see col. 25, lines 6-10, Matsumi), and appending information indicating an absence of the title information to

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said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is not obtained in said step of searching (see col. 28, lines 19-22 et seq, Matsumi).

wherein said title information comprises at least one of disc title, the name of a artist, genre, the year of sale of disc track title and the artist(s) for respective track(s) (see Fig. 32).

Matsumi does not explicitly indicate the claimed "communication network".

Fujinami discloses claimed communication network (as presentation media for presenting a computer program to be executed for carrying out the processing to the user, communication media network and a satellite can be used in addition to a magnetic disc, a CD-ROM and a recording medium such as solid-state memory, see col. 24, lines 45-50, Fujinami).

It would have been obvious to one ordinary skill in the recording media processing art at the time of the present invention to combine the teachings of the cited references because the communication network of Fujinami's teachings would have allowed Matsumi's system in the recording/playback environment to capable of recording data distinguishing overwrite recording from append recording as suggested by Fujinamo at col. 1, lines 11-14. Communication network as taught by Fujinamo improves to judge the indication of append-recording (see col. 1, lines 50-51, Fujinamo).

As to claim 6,

Matsumi teaches the step of obtaining updated title information when the updated title information is supplied by way of an information recording medium or via the communication network (see col. 27, lines 21-29 and col. 28, lines 19-22, Matsumi);

the step of recording the updated title information obtained into said second recording unit, and searching through said second recording unit (after updating) for the title information corresponding to said program information appended with the information indicating the absence of the title information (see col. 28, lines 19-22, Matsumi); and

the step of appending the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is obtained by searching through said second recording unit after updating (see col. 27, lines 21-29 and col. 28, lines 19-22, Matsumi).

As to claim 7,

Matsumi teaches wherein, in said step of searching through said second recording unit after updating, said second recording unit after updating is searched through based on the management information for managing said program information appended with the information indicating the absence of the title information (see col. 28, lines 19-22, Matsumi).

With respect to claim 8,

Matsumi discloses a program recording medium having recorded a title information appending procedure program for allowing a computer to execute a process to append title information to program information reproduced from an information

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recording medium or program information supplied via a communication network so as to be recorded into recording device (see col. 6, lines 2-10, Matsumi), the title information appending procedure comprising:

the procedural step of recording said program information reproduced from the information recording medium or said program information supplied via the communication network into a first recording unit provided in said recording device (see col. 6, lines 6-10, Matsumi);

the procedural step of, when said program information is recorded into said first recording unit, obtaining management information for managing said program information recorded in the information recording medium or supplied via the communication network, and, based on the management information obtained, searching through a second recording unit equipped in said recording device provided for pre-recording the title information corresponding to said program information (see col. 27, lines 17-26, Fig. 12(a), Matsumi); and

the procedural step of appending the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is obtained in said procedural step of searching, and appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is not obtained in said procedural step of searching (see col. 28, lines 19-22, Matsumi).

wherein said title information comprises at least one of disc title, the name of a artist, genre, the year of sale of disc track title and the artist(s) for respective track(s) (see Fig. 32).

Matsumi does not explicitly indicate the claimed "communication network".

Fujinami discloses claimed communication network (as presentation media for presenting a computer program to be executed for carrying out the processing to the user, communication media network and a satellite can be used in addition to a magnetic disc, a CD-ROM and a recording medium such as solid-state memory, see col. 24, lines 45-50, Fujinami).

It would have been obvious to one ordinary skill in the recording media processing art at the time of the present invention to combine the teachings of the cited references because the communication network of Fujinami's teachings would have allowed Matsumi's system in the recording/playback environment to capable of recording data distinguishing overwrite recording from append recording as suggested by Fujinami at col. 1, lines 11-14. Communication network as taught by Fujinami improves to judge the indication of append-recording (see col. 1, lines 50-51, Fujinami).

As to claim 9,

Matsumi teaches the procedural step of obtaining updated title information when the updated title information is supplied by way of an information recording medium or via the communication network (see col. 27, lines 21-29 and col. 28, lines 19-22, Matsumi);

the procedural step of recording the updated title information obtained into said second recording unit, and searching through said second recording unit after updating for the title information corresponding to said program information appended with the information indicating the absence of the title information (see col. 28, lines 19-22, Matsumi); and

the procedural step of appending the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is obtained by searching through said second recording unit after updating (see col. 27, lines 21-29 and col. 28, lines 19-22, Matsumi).

As to claim 10,

Matsumi teaches wherein said procedural step of searching through said second recording unit after updating includes the procedural step of searching through said second recording unit (after updating) based on the management information for managing said program information appended with the information indicating the absence of the title information (see col. 28, lines 19-22 et seq, Matsumi).

Remarks

4. In response to applicant's arguments regarding 'title information is appended to each individual data file' and Matsumi teaches this limitation as, by recording file system information B having the data having already been recorded and the append-recorded data, a normal condition can be restored, see col. 27, lines 30-32 and lines 59-61, Matsumi.

In response to applicant's arguments regarding 'appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit' and Matsumi teaches this limitation as, the file system information A is recorded in data having already been recorded. The same file system information A is recorded twice, and the information title end indicating the end position of the program is set so as to indicate the recording end position of the entry of first file system information and then recorded. The file system information A is recorded in two adjacent areas; an address indicating the position between the two areas is recorded at the predetermined position of the tape 110 or on the additional recording medium 113. After recording is carried out, if additional recording is carried out by a conventional apparatus not conforming to the file system information, the file system information A recorded at the second time is not recognized, data is recorded from the information title end indicating the end position of the program, and the file system information A recorded at the second time is deleted completely. In this condition, an abnormal condition can be recognized because two pieces of the file system information A are not present, and file restructuring can be carried out without problems hereafter because the file system information A itself regarding filed data having already been recorded remains. By recording the file system information B having the data having already been recorded and the append-recorded data the normal condition can be restored, see col. 27, lines 35-61, Matsumi.

In response to applicant's arguments 'function of appending the title information obtained to said program information so as to be recorded into said first recording unit in

the case that title information corresponding to said program information corresponding to said program information is obtained searching through said second recording unit based on management information obtained' and Matsumi teaches this limitation as stated above.

In response to applicant's arguments 'control means for, when said program information is recorded into said first recording unit,...'. and Matsumi teaches this limitation as a control means for controlling said recording/reproducing means in accordance with said command signals or said operation signal, see col. 7, lines 46-50, Matsumi.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Matsumi does not explicitly indicate the claimed "communication network". Fujinami remedy such kinds of deficiency by teaching as presentation media for presenting a computer program to be executed for carrying out the processing to the user, communication media network and a satellite can be used in addition to a magnetic disc, a CD-ROM and a recording medium such as solid-state memory, see col. 24, lines 45-50, Fujinami). It would have been obvious to one ordinary skill in the recording media processing art at the time of

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the present invention to combine the teachings of the cited references because the communication network of Fujinami's teachings would have allowed Matsumi's system in the recording/playback environment to be capable of recording data distinguishing overwrite recording from append recording as suggested by Fujinami at col. 1, lines 11-14. Communication network as taught by Fujinami improves to judge the indication of append-recording (see col. 1, lines 50-51, Fujinami).

In response to applicant's argument regarding means plus functions, Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

Interpretation of Claims-Broadest Reasonable Interpretation

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 162 USPQ 541,550-51 (CCPA 1969).

Reference is made to MPEP 2144.01 - Implicit Disclosure

"[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)

Subsequent to an analysis of the claims it was revealed that a number of limitations recited in the claims belong in the prior art and thus encompassed and/or implicitly disclosed in the reference (s) applied and cited. It is logical for the examiner to focus on the limitations that are "crux of the invention" and not involve a lot of energy and time for the things that are not central to the invention, but peripheral. The examiner

is aware of the duties to address each and every element of claims, however, it is also important that a person prosecuting a patent application before the Office or an stakeholders of patent granting process make effort to understand the level of one of ordinary skill in the (data processing) art or the level one of skilled in the (data processing) art, as encompassed by the applied and cited references. The administrative convenience derived from such a cooperation between the attorneys and examiners benefits the Office as well the patentee.

In view of the above, the examiner contends that all limitations as recited in the claims have been addressed in this Action.

For the above reasons, Examiner believed that rejection of the last Office action was proper.

In response to applicant's argument, to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

In re Keller, Terry, and Davies, 208 USPQ 871 (CCPA 1981).

"Reason, suggestion, or motivation to combine two or more prior art references in single

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invention may come from references themselves, from knowledge of those skilled in art that certain references or disclosures in references are known to be of interest in particular field, or from nature of problem to be solved;" Pro-Mold and Tool Co. v. Great Lakes Plastics Inc. U.S. Court of Appeals Federal Circuit 37 USPQ2d 1626 Decided February 7, 1996 Nos. 95-1171, - 1181

"[q]uestion is whether there is something in prior art as whole to suggest desirability, and thus obviousness, of making combination." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al. U.S. Court of Appeals Federal Circuit 221 USPQ 481 Decided Mar. 21, 1984 No 83-1178.

In response to applicant's arguments regarding combination of references does not teach or suggest the invention reasons have been provided as stated above.

Hence, Applicants' arguments do not distinguish over the claimed invention over the prior art of record.

In light of the foregoing arguments, the 103 rejections are hereby sustained.

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is (571) 272-4105. The examiner can normally be reached on Monday-Thursday (7:30 am-6:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Mohammad Ali', is positioned above the printed name.

Mohammad Ali
Primary Examiner
Art Unit 2166

MA
December 13, 2005